

REMARKS / ARGUMENTS

Except for the last four lines appearing at the bottom of page two of the instant office action, paragraphs 1 through 4 of the action are identical to the text of the same numbered paragraphs of the office action previously mailed to applicant on January 4, 2005 (including the continued rejection of claim 2 even though claim 2 was cancelled after its subject matter was incorporated into claim 1). Applicant therefore renews without restatement in this response all arguments previously asserted in response to those paragraphs in the papers mailed May 4, 2005, and filed May 9, 2005. Applicant's response to the four newly added lines follows below in response to the examiner's remarks as presented in paragraph 5 of the instant action, where the same four lines are again repeated.

In paragraph 5 of the instant action, the examiner acknowledges the Declaration of Susan Knox. The examiner does not, however, either acknowledge or otherwise address the contents of the Second Declaration of Susan Crawford Pope, filed simultaneously with the Declaration of Susan Knox, even though it was prominently mentioned and argued at pages 6 and 7 of the Amendment After Final Rejection (entered upon filing of the RCE) to which the instant action is responsive. The examiner also refused to consider the contents of said declaration when originally filed, thereby necessitating in part the filing of the RCE. Until the Second Declaration of Susan Crawford Pope has been fully considered and Applicant has been provided an opportunity to respond to any comment regarding its contents, Applicant respectfully submits that a final rejection is inappropriate.

In discounting the Declaration of Susan Knox, the examiner speculates that PetsMart "can provide" extensive advertising "which may" influence consumers to purchase the yard stake. In so doing, the examiner apparently discounts totally the following statements made by Ms. Knox:

- “Because the scent of the Pee Post yard stake encourages marking behavior, dogs are easily trained to eliminate near the stake.” (Page 2, par. 2, emphasis supplied)
- “. . . [E]ach year I review approximately 2,000 new products that are shown or offered to [PETsMART] by representatives of various manufacturers. I am also generally aware of pet products offered for sale by many of our principal competitors. Except for the Pee Post yard stake made by [Applicant’s company], I have never been shown and am not aware of any commercially available yard stake or similar pet product that is intended for use in training a pet to eliminate in a particular outdoor area.” (Page 2, par. 4, emphasis supplied)
- “The Pee Post yard stake has been well received by our customers, and our sales of the product during the past year make it one of our best-selling new products. Based upon my considerable experience in this industry, it is clear to me that [Applicant’s] Pee Post yard stake is a commercially successful product and is meeting a longstanding need that was not previously being met by any other commercially available product of which I am aware.” (Page 2, par. 5, emphasis supplied)

In commenting on the Knox declaration at the top of page 7 of the instant action, the examiner focuses exclusively on the portion of her statements that address commercial success of the claimed invention, and apparently ignores her statements, equally probative of nonobviousness, that: (1) the subject yard stake “encourages marking behavior” [not “attracts dogs”] (2) is not replicated by “any commercially available yard stake or similar pet product” that she has ever been shown or of which she is aware; and (3) “is meeting a longstanding need that was not previously being met by any other commercially available product” of which she is aware.

Instead, the examiner attacks the Knox declaration *only* for failing to provide evidence that PetsMart did not provide extensive advertising *which may* have influenced consumers to buy the product. In direct response to that attack, Ms. Pope's Second Declaration states that the "enthusiastic response of pet-knowledgeable consumers to the solution provided" by her invention "has not been created by exceptional or extraordinary promotional efforts or by extensive advertising. . ." (Par. 5, emphasis supplied)

As objective evidence of the widespread market recognition received by the subject product, the Second Declaration of Susan Pope also presents a Google search identifying 41 other online marketers who offer the claimed product for sale on their websites. Rather than addressing such evidence and its implications for establishing nonobviousness of the invention, in Par. 5 of the action, the examiner mischaracterizes a statement made by Applicant's undersigned counsel and reverts to the combination of Mohammed and Fain in support of the stated rejections.

In the first subtitle at page 7, the examiner states, "Applicant argued that Mohamed nor any prior art mentions a yard stake." That statement is not correct. Applicant instead stated: "However, neither Mohamed nor any of prior art discussed *in the background portion of Mohamed's specification* even mentions a yard stake."

The examiner also apparently ignores Applicant's argument that Mohamed teaches against use of the particular scents recited in the rejected claims, ". . . instead requiring β -ionone and other untested but 'expected to work' ionone analogs."

In an effort to buttress the plain deficiencies of Mohamed as an obviating reference, and without apparent regard for the clear teaching of Mohamed as to ionone analogs required for use in his invention, the examiner maintains his reliance on Fain.

Fain, however, simply discloses a stake-mounted container housing "odorous substances" having either "a pungent odor known to repel unwanted animals" or "a captivating odor to attract desirable creatures." Fain discloses nothing about substances known to "encourage marking behavior" (as stated by Ms. Knox) or for "inducing the canines to eliminate in a vicinity where the yard stake is placed" as recited in Applicant's claims.

Apparently recognizing the need for additional support for the rejection based on Mohamed in view of Fain, the examiner also refers to Corbett (previously cited and withdrawn) and Dawson (previously cited but not applied). Corbett discloses a stake for use by hunters to attract a game animal or to mask the hunter's human scent, or alternatively, as a dispenser for air freshener or an insect repellent. Dawson discloses a combustible incense stick impregnated with a fragrance that is attractive to an animal and covers the scent of human beings. Neither of these supplemental references is seen to overcome the deficiencies of Mohamed and Fain as an obviating combination of references.

At the bottom of page 7, the examiner characterizes what he considers to be "Applicant's main argument." Applicant does not adopt that characterization. Applicant does, however, believe that none of the cited references (whether taken alone or in combination with other cited references or in combination with what would otherwise be obvious to one of ordinary skill in the art) renders obvious the combined use of p-cresyl acetate and phenyl acetic acid in a yard stake as recited in Applicant's rejected claims. In the first Declaration of Susan Pope, Ms. Pope stated that she previously tried "numerous different compositions without success." None of the other compositions she tried "was effective for inducing a dog to eliminate in that location." Perhaps most significantly, none of the many prior art references relied upon by the examiner is seen to disclose this particular combination of recited substances that the examiner considers to be so obvious.

Referring to pages 8-10 of the action, the examiner asserts without support that p-cresyl acetate and phenyl acetic acid are both considered to be attractants to animals. He also infers from that assertion that both are known to induce canines to eliminate. Neither the assertion nor the inference has been shown to be established in the prior art. Next, the examiner assumes without support that (1) inducement of marking behavior and elimination is simply a matter of potency, and (2) that the two recited components are more potent than others. Neither of these points is established by the prior art upon which the examiner relies in rejecting the pending claims. Instead, the examiner impermissibly interjects his personal opinion and impermissibly requires Applicant to further prove that the two recited components are *necessary*, rather than effective or preferred, for use in the subject invention. The examiner bears the burden of establishing a *prima facie* case of obviousness. Here the examiner has failed to meet that burden as to every element of the rejected claims, and has also impermissibly disregarded the evidence of secondary considerations that should apply, assuming only for sake of argument that the burden was met.

All pending rejections are therefore traversed, and reconsideration and withdrawal of the rejections is respectfully requested.

Please charge any additional fee that may be required or credit any overpayment to Deposit Account No. 12-1781 of Locke Liddell & Sapp, LLP.

Respectfully submitted,



Monty L. Ross
Registration No. 28,899
(214) 740-8519

MLR:
DECEMBER 27, 2005

LOCKE LIDDELL & SAPP LLP
2200 Ross Ave., Suite 2200
Dallas, Texas 75201-6776
(214) 740-8519 Telephone
(214) 756-8519 Facsimile